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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,654	07/27/2004	Gary A. Deeter	JD-308	4653
25884	7590	10/03/2006		
JOHNSON POLYMER, INC. 8310 16TH STREET- M/S 510 P.O. BOX 902 STURTEVANT, WI 53177-0902			EXAMINER MULLIS, JEFFREY C	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/710,654

Applicant(s)

DEETER ET AL.

Examiner

Jeffrey C. Mullis

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 5-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 5-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7-13-06</u> | 6) <input type="checkbox"/> Other: _____ |

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All previous rejections are hereby withdrawn.

Claims 1 and 5-73 are objected to since a claim must be in the form of a complete sentence and claims 1 and 5-73 lack a period.

The amendment filed 7-20-06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicants amendment adding a paragraph after paragraph 45 introduces new matter since PDI's of 28, 32 and 45 are not disclosed in the specification as filed.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 10, 15, 21, 28, 45, 60, 66, 67, and 71 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Molar ratios of diene monomer of 01-10 are not disclosed by the specification as filed nor are compositions having 01 % oligomer or 05% epoxy monomer or molar ratios of oligomer to anionically polymerized monomer of 002 or 005% % oligomer or 05% epoxy monomer 53 or 05% functional monomer or polydispersity indexes of 15 or 05% epoxy functional monomers. These limitations are therefore new matter.

Claims 1 and 5-73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claims recite an oligomer which may be produced by reaction of an "ester functional monomer" and another monomer which may also be an "ester functional monomer" and for this reason it is unclear if two identical monomers may be polymerized to produce an (homopolymer) oligomer.

Claim 25 lacks antecedent basis in any preceding claim in that the "anionically polymerizable monomer" is not recited in any preceding claim.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-8, 12-19, 21-23, 25, 26, 28-38, 45-53, 56-63 and 73 are rejected under 35 U.S.C. 102(b) as being anticipated by Emmons et al. (US 4,120,839).

Patentees disclose a process utilizing an anionically produced polyether epoxy polymer (see "IV" and "V" in column 7) and a free radically produced acrylate in Example 4 with applicants characteristics (which of course would have ester functionality as part of the acrylate). Note Example 14 for an example using the Example 4 material.

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The Castan patents, newly cited are incorporated by reference by Emmons et al.

Any inquiry concerning this communication should be directed to Jeffrey C. Mullis

M-F, 9-5pm at telephone number 571 272 1075.

Jeffrey C. Mullis

J Mullis

Art Unit 1711

JCM

9-22-06

Jeffrey Mullis
Primary Examiner
Art Unit 1711

A handwritten signature in black ink, consisting of a large, stylized 'J' followed by a smaller 'M' and a trailing flourish.